

REMARKS

The Non-final Office Action, mailed July 21, 2008, considered claims 2-4, 7-9, 12, 14-16, 18-21, 29-34 and 36-39. Claims 2-4, 7-9, 12, 14-16, 18-21, 29-31, 33, 34 and 36-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cameron et al., U.S. Patent Pub. No. 2003/0004964 (filed Nov. 26, 2001) (hereinafter Cameron), in view of Krishnaprasad et al., U.S. Patent Pub. No. 2002/0078094 (filed Sep. 6, 2001) (hereinafter Krishnaprasad).

Claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Cameron, in view of Krishnaprasad et al., and further in view of Traversat et al., U.S. Patent No. 6,366,954 (filed Jan. 29, 1999) (hereinafter Traversat).¹

As a preliminary matter, Applicant thanks the Examiners (Stace, Mofitz, and Trans) for the courtesies extended during the recent telephonic conversations regarding this matter. Details of those conversations are included herein.

Additionally, Applicant notes that while no arguments have been made with respect to the teaching of the cited art, this should not be construed as an acquiescence that the Applicant agrees with the Examiner's characterization of the cited art. Indeed, Applicant disagrees with the characterization and further disagrees with the stated motivations to combine asserted in the Office Action. Nonetheless, in the interest of simplifying the issues, Applicant is addressing only the availability of Cameron as a reference under 35 U.S.C. § 103(a).

By this paper, no claims have been amended as Applicant respectfully traverses the rejections. In particular, Applicant has previously submitted declarations on May 12, 2008 and December 26, 2007 under 1.131 to establish conception and an actual reduction to practice. Further, while Applicant has also submitted additional evidence in the form of an email correspondence which tends to corroborate the statements made in the declarations, such additional evidence is not necessary to establish conception and reduction to practice.

The entirety of the basis for the Examiner's decision that the Declarations are insufficient to establish a conception and reduction to practice is set forth below:

¹ Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

This evidence, however, by itself, fails to support the conclusion alleged in the Applicant's declarations that the claimed invention was conceived of and reduced to practice prior to 2 January 2003. As such, the Applicants have failed to meet their burden under 37 C.F.R. 1.131(b)

Conception

The affidavit's and evidence submitted (sic) is insufficient to establish a conception of the invention prior to the effective data (sic) of the Cameron reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The Affidavit of 5/12/08 declares that a prototype of the invention was created. However, there is no evidence of this. As such, there is no demonstrative evidence to show complete conception of the invention at the date of the email communication stated.

Reduction To Practice

In this case, an actual reduction to practice is alleged to have occurred prior to 2 January. However, actual reduction to practice is not fully supported by the email document or the allegations of facts in the Affidavits.

Applicant disagrees with the Examiner's analysis. In the second paragraph of the text above, the Examiner highlights that conception can be established by a complete disclosure to another. The Affidavit sent on May 12, 2008 establishes this complete disclosure. The declaration states "Shortly after the email exchange, and prior to January 2, 2003, Andy Harjanto demonstrated a prototype of the invention disclosed in the email exchange." It should be noted that these statements are sworn statements made under penalty of perjury. Further Applicant's respectfully submit that the best evidence for showing that a complete disclosure to another took place, is a statement by the individual to whom the disclosure was made. This is the exact nature of the evidence submitted. This evidence is also sufficient to establish a reduction to practice.

The Examiner's decision to not give the Declarations appropriate weight is in error. The Examiner's decision appears to be taking the position that a statement in a Declaration is not evidence of sufficient weight to establish a reduction to practice. This is contrary to law. A statement in a Declaration, executed under penalty of perjury, is evidence. Whereas a mere allegation might not be of sufficient weight, the Declarations in this case were executed under penalty of perjury and are of such weight. The M.P.E.P. explains that "averments made in a 37 C.F.R. 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his

or her own affidavit or declaration if he or she so elects." MANUAL OF PATENT EXAMINING PROCEDURE § 715.07, p. 700-251 (8th ed., Rev. 7, July 2008).

For this proposition, the M.P.E.P. cites *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953). In *Hook*, the Examiner held a 131 affidavit to be insufficient because, *inter alia*, "there is no corroboration of either the averments or exhibits presented in the affidavit." *Id.* at 131. The Patent Office Board of Appeals reversed the Examiner on this point, stating: "We are unable to sustain the examiner's holding that the averments made by an affiant in a Rule 131 affidavit must be corroborated. . . . An applicant has the right to stand upon his own affidavit if he so elects." *Id.* In the present case, Applicant has not only provided Declarations, which on their own are sufficient to establish conception and reduction to practice, Applicant has also provided an email exchange which strongly corroborates the averments made in the Declarations. Nonetheless, the Declarations are sufficient to establish reduction to practice and conception absent this additional evidence. Applicant respectfully submits that Applicant should not be penalized for providing more evidence than what is required.

Applicant reasserts herein the arguments previously submitted showing why Cameron should be removed as a reference.

In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 21st day of October 2008.

Respectfully submitted,

/J. LAVAR OLDHAM/

RICK D. NYDEGGER
Registration No. 28,651
J. LAVAR OLDHAM
Registration No. 53,409
Attorneys for Applicant
Customer No. 47973

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